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OFFICE OF PETITIONS

In re Patent No. 7,423,119	:	DECISION ON REQUEST
Goddard et al.	:	FOR
Issue Date: 09/09/2008	:	RECONSIDERATION OF
Application No. 10/063,617	:	PATENT TERM ADJUSTMENT
Filed: 05/03/2002	:	and
Atty Docket No.	:	NOTICE OF INTENT TO ISSUE
P3230R1C001-168	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on September 29, 2008,¹ which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted, by eight hundred thirty-nine (839) days. As further explained herein, the patent term adjustment is five hundred fifty-seven (557) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by five hundred fifty-seven (557) days is **GRANTED to the extent indicated herein.**

As to the "B" delay, the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on May 4, 2005, and ends on May 21, 2006, the day before the RCE was filed, or 383 days. See 35 U.S.C.

¹ A petition under 37 CFR 1.705(d) was filed on September 29, 2008, but was not coded as a petition. An additional paper styled as a petition was filed on November 6, 2008. Accordingly, the paper filed on November 6, 2008, will be considered as a supplement to the earlier filed petition. The duplicate petition fee paid on November 6, 2008 will be refunded to counsel.

154(b)(1)(B)(i). Patentees fail to account, however, for the number of days in the period beginning on the date a notice of appeal was filed, October 27, 2005, and ending on the day before the RCE was filed, or 207 days. Time consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. § 154(b)(1)(B)(ii). Accordingly, the period of "B" delay is 176 (383 - 207) days.

Patentees further assert that the 63 day period of reduction for applicant delay in connection with the filing, on January 29, 2008, of a miscellaneous incoming letter, should be removed. Specifically, patentees state that the paper filed on January 29, 2008 was a letter regarding the patent term adjustment calculation.

Upon review, patentees are correct. A review of the record reveals that the paper filed on January 29, 2008, was a letter regarding the patent term adjustment. This is not among the types of papers which are considered a failure to engage in reasonable efforts to conclude processing or examination. Accordingly, the 63 day period of reduction for applicant delay is not warranted and will be removed.

It is noted, however, that on January 16, 2008, a request to correct the inventorship was filed, after the mailing of the notice of allowance. On March 31, 2008, 75 days after the request to correct the inventorship was filed, the Office mailed a response to the request to correct the inventorship.

37 CFR 1.704(c)(10) states:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed

and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months; and

Further, as set forth in MPEP 2732:

Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See Clarification of 37 CFR 1.704(c)(10) - Reduction/of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office). Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations.

A request to correct (amend) the inventorship is not among the types of papers which will not be considered a failure to engage in reasonable efforts to conclude processing or examination. Rather, the O.G. and the MPEP state that an amendment filed after the mailing of the notice of allowance is among the types of papers which are considered a failure to engage in reasonable efforts to conclude processing or examination. Accordingly, a 75 day period of reduction is warranted and will be entered.

It is further noted that the table accompanying the petition filed on November 6, 2008 notes a one (1) day reduction for the filing of an RCE on November 9, 2006, three (3) months and one (1) after the mailing of a final Office action on August 8, 2006. In view of this petition and the letter filed on January 29, 2008, this is treated as a letter pursuant to patentee's good faith and candor. As the RCE filed on November 9, 2006, was filed three (3) months and one (1) day after the mailing of the Office action mailed on August 8, 2006, a one (1) day reduction for applicant delay is due pursuant to 37 CFR 1.704(b).

The patent term adjustment is increased to 557 ($605 + 176 - 224$ ($75 + 72 + 1 + 1 + 75$)) days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136. See 37 CFR 1.323(a)(4).

The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by five hundred fifty-seven **(557)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,423,119 B2

DATED : September 9, 2008

DRAFT

INVENTOR(S) : Goddard et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 394 days.

Delete the phrase "by 394 days" and insert – by 557 days--